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09/679,039	10/04/2000	Paul E. Jacobs	PA000373	5558
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Qualcomm Incorporated Patents Department 5775 Morehouse Drive San Diego, CA 92121-1714			ALVAREZ, RAQUEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/679,039

Applicant(s)

JACOBS ET AL.

Examiner

Raquel Alvarez

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 1/23/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40, 111-113, 126, 127, 136, 137 and 146 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40, 111-113, 126, 127, 136, 137 and 146 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10</u> . | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This office action is in response to communication filed on 1/23/2004.
2. Claims 1-40, 111-113, 126, 127, 136, 137 and 146 are presented for examination.

#### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-40, 111-113, 126-127, 136-137 and 146 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 and 51-53 of copending Application No.09/668,553.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites transmitting ad-statistical data. Calculating and transmitting statistical data it is old and well known in business in order to calculate and transmit statistical data in order to make educated assumptions and statements on a particular subject. It would have been obvious to a person of ordinary

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skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-40, 111-113, 126, 127, 136-137 and 146 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (5,848,397 hereinafter Marsh) in view of Montague (6,298,332 hereinafter Montague).

With respect to claims 1-6, 9, 12-13, 16, 18-20, 26, 32, 35, 111, 112, 113 Marsh teaches software for use on a client device that is configured for communications with at least one remote source of advertisements via a communications network (Abstract). An advertisement download function that downloads advertisements from at least one remote source, during one or more advertisements download sessions (see figure 4, item 601); an advertisement store function that stores the download advertisements on a storage medium associated with the client device (col. 14, lines 1-10); an advertisement display function that effects display of at least selected ones of the stored advertisements on a display associated with the client device (Figure 6, 702); an audit function that compiles as-related statistical data relating to the downloaded

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advertisements, wherein the ad-related statistical data includes display event-related data regarding advertisements that were displayed during a prescribed audit interval (col. 14, lines 66-, col. 15, lines 1-7); an audit data transmit function that transmits the ad-related statistical data to a prescribed server system (Figure 8 and col. 15, lines 10-20).

Marsh teaches sending the statistical data to the server (Figure 8 and col. 14, lines 66-, col. 15, lines 1-20). Marsh does not specifically teach sending the data only in response to a user's grant permission to do so. Montague teaches delivering vendor-supplied information to a purchase, while the purchaser authorizing transmission of various data to a vendor server or a third party server (col. 9, lines 20-24). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Marsh the teaching of Montague of sending the data only in response to a user's grant permission to do so because such a modification would allow the users to have controlled of the data that is transmitted.

With respect to claim 7, Marsh further teaches under a client policy transmitting a statistical sampling of a population of client devices, at prescribed times (col. 3, lines 12-27 and col. 7, lines 7-24).

Claim 8 further recites transmitting to random ones of population of client devices at prescribed times. Official notice is taken that it is old and well known to perform a function at random in order to protect the data been transmitted. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have

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included transmitting the audit at random times in order to obtain the above mentioned advantage.

With respect to claims 10-11, 14-15, 17, 29 Marsh further teaches that the client information includes user demographic data and transmitting the information to the prescribed server system (col. 3, lines 12-27).

With respect to claims 21, 27, 30, 33 and 36, Marsh further teaches that the advertisement distribution server system is managed by a producer of the software (col. 3, lines 12-56).

With respect to claims 22, 28, 31, 34 and 37, Marsh further teaches that the advertisement distribution server system is managed by a distributor of the software (col. 3, lines 12-56).

With respect to claim 23, Marsh further teaches that the communication network is the Internet (Figure 8, 107).

With respect to claim 24, Marsh further teaches that the software is e-mail software (see Figure 8).

Claims 25, 38-40 further recite that the client information includes the distributor identifier for transmitting the client information to the prescribed server system. Marsh teaches transmitting the client information to a prescribed server system (Figure 8 and col. 15, lines 10-20 and col. 14, lines 66-, col. 15, lines 1-20). Marsh does not specifically teach including the distributor identifier. Official notice is taken that it is old and well known to provide identity information such as a name or number in order to point out individuality between the subjects. It would have been obvious to a person of

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ordinary skill in the art at the time of Applicant's invention to have included the distributor identifier in order to obtain the above mentioned advantage.

With respect to claim 126, Marsh further teaches that advertisement display function effects display when the client device is offline (col. 6, lines 63-, col. 7, lines 1).

With respect to claim 127, Marsh further teaches that the advertisement display function effects display while the user is composing/reading e-mail messages (col. 7, lines 1-6).

Claims 136-137 further recite that the audit data is transmitted at activated random times. Marsh teaches transmitting audit data (col. 14, lines 66-, col. 15, lines 1-7). Marsh does not specifically teach transmitting the audit data at random times. Official notice is taken that it is old and well known to perform a function at random in order to protect the data been transmitted. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting the audit at random times in order to obtain the above mentioned advantage.

With respect to claim 146, Marsh further teaches clickthrough data regarding each advertisement that was clicked on by the user during the prescribed audit interval (col. 15, lines 14-20).

### **Response to Arguments**

5. The 112, 2<sup>nd</sup> rejection has been withdrawn based on Applicant's remarks.
6. With respect to the provisional obviousness-type double patenting, it is noted that Applicant is reserving response to the provisional double patenting rejection until all other issues of patentability are settle in both applications. Therefore, since Applicant

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does not contest the rejection nor submit a terminal disclaimer to overcome such rejection, the double patenting rejection is sustained.

7. As a matter of formalities, it is noted that the prior office action contained a typographical error. Namely the heading of the 103 rejection should have included all the claims (claims 1-40, 111-113, 126, 127, 13-137 and 146) and also the heading should have included the Montague reference (in view of Montague). Accordingly, as corrected claims 1-40, 111-113, 126, 127, 136-137 and 146 are rejected over Marsh in view of Montague. This correction, however should not be considered as a new ground of rejection. In fact, all the claims were properly addressed in the content of the rejection.



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8. Applicant argues that the references do not teach "a send audit data display window that requests the user's permission to transmit ad-related statistical data to the prescribed server system". The Examiner respectfully disagrees with Applicant because Marsh teaches on col. 14 lines 66 to col. 15 lines 1-20 that the statistics log file is stored in storage 101 and that is sent to sever system 104, which uses the statistics to determine which advertisements to subsequently present to the user. Furthermore, Montague clearly teaches on col. 9, lines 20-24 that "a user can selectively authorize transmission of various data to a vendor or an independent third party server according to only authorizations selected by a user". Therefore the combination of Marsh and Montague teaches "the audit data transmit function transmits the ad-related statistical data only in response to user's grant permission to do so".

9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., protection of the user's privacy) are not recited in the rejected claim(s). Although

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the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. In response to applicant's argument that the user's permission is to protect the privacy of the user, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

12. The Applicant has focused on the statistical data being used for billing purposes and has overlooked the additional teachings of the "information can also be used at the server system 104 by the advertisement distributor scheduler and the advertisement download scheduler" (col. 15, lines 9-13) in order to determine which advertisement to subsequently present to the user (col. 15, lines 7-9). "The advertisement distribution scheduler is located at the server system 104" (col. 15, lines 31-53). Therefore, the ads viewed by the user are not only sent for billing purposes but also to target future ads.

13. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Marsh and

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Montague can be easily combined to send only data in which a user has grant permission to do so because such a modification would allow the user to have control of the ads that are being targeted to him or her.

14. With respect to claim 7, Applicant argues that Marsh doesn't teach a client policy for transmitting the statistical data at prescribed times. The Examiner respectfully disagrees with Applicant because Marsh teaches that the user allows the system to collect statistical information such as user's hobbies, interest employment, etc. this information is collected and passed on to the server system (col. 3, lines 12-27).

Therefore, a client policy exists to allow the data to be collected and transmitted.

15. With respect to arguments to claim 8, the Applicant has agreed with Examiner that performing a function at the random is old and well known in the computer related arts to avoid general data problems. Nevertheless, Applicant argues that in instant application, the performing of the random function is not directed to software problems. The Applicant is reminded that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

16. With respect to claims 21, 22, 27, 28, 30, 31, 33, 34, 36 and 37, Applicant argues that Marsh doesn't teach that the advertisement distribution server system is managed by either a producer or a distributor of the software. The Examiner respectfully disagrees with Applicant because Marsh teaches that the client program or producer of the software determines which advertisements to present and when (col. 3, lines 53-54).

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17. With regard to the examiner's use of Official Notice, applicant asserts that "is not and cannot be of such notorious character as to merit official notice" to substantiate the examiner's assertion, but this is not relevant to the use of Official Notice. While applicant may challenge the examiner's use of Official Notice, applicant needs to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of. See MPEP 2144.03 where In re Boon is mentioned.

18. In light of the above, it is the Examiner's position that Marsh in combination with Montague teach the claimed limitations.

**Conclusion**

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Point of contact**

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20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez  
Examiner  
Art Unit 3622

R.A.  
4/12/04